In re Application of

E. Scirbona   Atty. Docket: JON-125

Serial No. 9/943274   Group Art Unit: 3729

Filed: 8/31/01   Examiner: R. K. Chang

Title: Battery Powered Wire Insertion Impact Tool

AMENDMENT

In response to the Office Action dated 11/3/03, it is difficult to understand the basis for the requirement to elect, since, according to the Examiner, both claim groups are searchable in the same class and subclass. Moreover, the Examiner's logic is equally a mystery. What is the significance of the claim 1 group being usable without claim element (e), since that combination is not being claimed! Moreover, claim 6, the lead claim in the second group, does not have a "second means", so again the significance of the Examiner's statement is not understood.

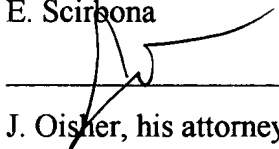Accordingly, the requirement is respectfully controverted.

However, should the Examiner adhere to his requirement, applicant elects for further prosecution in this application the claims in Group II, namely, claims 6-17.

Concerning Par. 6 of the Office action, the basis for this requirement is not understood. Rule 1.111 applies only when the claims have been rejected on their merits. The current Office action has not examined the claims on their merit. Moreover, MPEP 2163.06 applies to new matter. Applicant has not amended the claims so it is not seen how MPEP 2163.06 applies. Clarification is requested.

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For completeness sake, the Examiner's attention is directed to USP 5,794,325. This patent also is directed to a Battery Powered Wire Insertion Impact Tool and thus may have some relevance to the claims of this case.

Respectfully submitted

E. Scirbona

11/10/03

J. Oisher, his attorney

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